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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,775	06/30/2003	John C. Hill	FLORA.1300	1915
39602 7590 09/25/2007 NOBLITT & GILMORE, LLC. 4800 NORTH SCOTTSDALE ROAD SUITE 6000 SCOTTSDALE, AZ 85251			EXAMINER GHALI, ISIS A D	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 09/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/611,775	Applicant(s) HILL, JOHN C.	
	Examiner Isis A. Ghali	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-40 is/are pending in the application.
- 4a) Of the above claim(s) 23-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/22/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examination of this case has been transferred from examiner Jyothsna Venkat to examiner Isis Ghali

The receipt is acknowledged of applicant' election filed 07/16/2007, IDS filed 05/22/2006, and IDS filed 06/30/2003.

Information Disclosure Statement

1. The information disclosure statement filed 06/30/2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the 1449 form does not list any references. It has been placed in the application file, but no information referred to therein to be considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claims 1-22 have been canceled. Claims 23-40 are pending

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Claims 23-34 have been previously withdrawn from consideration as being directed to non-elected invention.

Claims 35-40 are included in the prosecution.

Election/Restrictions

1. Applicant's election with traverse of species jojoba oil in the reply filed on 07/16/2007 is acknowledged. The traversal is on the ground(s) that searching all the species is not burden on the examiner and searching claim 36 would not broaden any search done for claim 35 because the generic variants of claim 36 all demonstrate the qualities of the organic materials as claimed by claim 35, and the prior art that is relevant to any generic variant of claim 36 would likely to be discovered in searching claim 35.

This is not found persuasive because searching each species will require searching different classes and subclasses or electronic resources, or employing different search queries. For example searching for plant oil requires searching different classes and subclasses and electronic resources that are distinct from searching for oils from fungi and microorganisms. The search system and the focus of the invention are completely different, requiring an undue burden on the patent examiner. While searches may seem to be overlapping, however extensive since the patent examiner searches the databases mostly literally. Rarely do applicants present species where the distinctness of the species is readily clear such as a chemical compound and a gene

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sequence. It is the responsibility of the examiner to enforce 35 USC 101, which allows the applicant to obtain a patent for a single invention. In the opinion of the examiner, applicant presents distinct species.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 23-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 07/16/2007.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 35-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantial benefit" in claims 35 and 38 is a relative term which renders the claim indefinite. The term is not defined by the claim, and the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Regarding claims 36 and 39, the expression "other microorganisms" does not set out the metes and bounds of the claim. Recourse to the specification does not define the expression in terms of what are the other microorganisms.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 35-40 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,649,177 ('177).

The present claims are directed to method of providing a benefit to a topical composition by adding hydrolyzed jojoba oil to acid gelling agent.

US '177 disclosed hydrolyzed jojoba oil added to cosmetic compositions to enhance their desirable properties (abstract). The reference disclosed hydrolyzing the jojoba oil by alkali (example 1). Applicants disclosed in page 14, first and second paragraphs that:

"The composition of materials created by the method according to the present invention are produced by the reaction of aqueous alkali metal hydroxides, e.g., NaOH, LiOH, KOH (the preferred hydroxide), CaOH, MgOH, and the like, with organic lipid compositions, usually plant extracts, oils, fats, or waxes (of the extracts or derivatives of

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the extracts) where the organic compositions contain a high proportion of unsaponifiable materials (greater than 6%), and preferably as long chain esters.

Jojoba oil may be examined as an example case. Refined jojoba oil contains various proportions of long chain diunsaturated esters. Hydrolysates of refined jojoba oil are nearly a 55:45 mixture of polar hydrophilic long chain salts (alkali salts) and relatively non-polar lipophilic materials (fatty alcohols). The lipophilic fraction is the unsaponifiable materials according to the definition used in this document. The carbon chain lengths of both of these jojoba Hydrolysates include and vary from C18 to C24 and have co-9 double bonds as part of each molecule. It has been found that the combination of saponifiable and unsaponifiable fractions of the Hydrolysates according to the present invention has properties that aid in the formulation of cosmetic, pharmaceutical, and other compositions."

Therefore, the reference disclosed the same method as applicant's method of obtaining the claimed composition that comprises polar hydrophilic salts and non-polar unsaponifiable materials. Hence, since the reference disclosed hydrolyzed jojoba oil produced by same method as applicant's method, then the composition produced by the reference will inherently have the same hydrolysis product. Jojoba oil inherently has the same amount of unsaponifiable materials prior to hydrolysis.

US '177 disclosed adding the jojoba oil product to cosmetic composition including gels (col.3, lines 4-20). The reference disclosed gel comprising carbomer (col.16, line 38 till col.17, line 18). Applicant disclosed carbomer as one of the acidic gelling agent in page 15 last paragraph.

The limitations of claims 35-40 are met by US '177.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Isis A Ghali
Primary Examiner
Art Unit 1615

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